

### **REMARKS**

Preliminarily, it is noted that the Office Action dated 03/17/2008 indicates that only claim 1 is in the application, and acts only on claim 1. As set forth in applicants' last Amendment, however, dependent claims 2, 4 and 5 also remain in the application. Claims 2, 4 and 5 will be treated herein as if rejected on the same grounds as claim 1.

Claim 1 has been amended in accordance with the Examiner's helpful suggestion (Office Action dated 03/17/2008, p. 3, numbered paragraph 4) to overcome the rejection under 35 U.S.C. §112, second paragraph, and has been further amended to emphasize that the claimed masking member has good heat resistance and good dimensional stability. The latter recital is supported by the disclosure of the original specification, e.g. at p. 2, lines 16-22 (paragraph [0008] in application publication No. 2006/0057411). Since this Amendment does not increase either the total number of claims or the number of independent claims, no additional fee is necessary.

Claims 1 (independent; amended) and 2, 4 and 5 (all directly or indirectly dependent on claim 1) are in the application. No claim has been allowed.

### ***The §112 Rejection***

As the Examiner has recognized, claim 1 should recite that the modified polypropylene sheet has 5 to 30% by weight of polyethylene (not "polypropylene") and/or ethylene-propylene copolymer mixed in with polypropylene. The error, inadvertently introduced in the last previous Amendment, has now been corrected, and is believed to overcome the rejection of claim 1 (and dependent claims 2, 4 and 5) as indefinite.

### ***The §102 Rejection***

Claim 1 has been rejected under 35 U.S.C. §102(b) as anticipated by JP 03059049A (Yamazaki et al.). In response, applicants respectfully submit that the present invention is characterized 1) by using a modified polypropylene sheet in which 5 to 30% by weight of polyethylene and/or ethylene-

propylene copolymer is mixed in with polypropylene, 2) the modified polypropylene sheet is vacuum and/or pressure formed, and 3) the resulting masking member has a non-planar, deep drawing or complex shape, and further, a good heat resistance and dimensional stability.

The reason why the aforesaid modified polypropylene is selected is that the modified polypropylene sheet has a good elongation so the sheet is easily vacuum and/or pressure formed in a non-planar, deep drawing or complex shape while the modified polypropylene sheet does not droop under its own weight in the vacuum and/or pressure forming, and further the resulting masking member has good heat resistance and good dimensional stability (see page 2 lines 16 to 22 in the original specification).

Yamazaki et al. discloses a polyolefin composition used for a large blow molded article, such polyolefin composition consisting of 40 to 80% by weight of polypropylene, 5 to 35% by weight of polyethylene, and 15 to 25% by weight of ethylene- $\alpha$ -olefin copolymer rubber. The object of the Yamazaki et al. invention is to solve the problem of drawdown in the blow molding because the parison (thermoplastic tube) for a large blow molded article may be heavy.

An object of the present invention is also to solve the problem of drooping (drawdown) of the thermoplastic sheet but another object of the present invention is to mold easily a masking member having a non-planar, deep drawing or complex shape as above described, and a further object of the present invention is to provide a masking member having good heat resistance and good dimensional stability.

Yamazaki et al. does not teach that the modified polypropylene sheet of the present invention has a good moldability in vacuum and/or pressure forming so that the modified polypropylene sheet gives a masking member having a prescribed, non-planar deep drawing shape or complex shape and further, this modified polypropylene has a good heat resistance to give a masking member having good heat resistance and good dimensional stability. Accordingly, the above described effect of the present invention would not have been obvious or expected, from the disclosure in Yamazaki et al., to persons of ordinary skill in the art.

The preamble of present claim 1 recites "A masking member for use in a coating process to protect from coating a specific part of an article that is being coated." The Office Action, as understood, dismisses this recital as a mere statement of use not entitled to weight as a limitation

in determining patentability. It is well settled, however, that a claim preamble will be given the effect of a limitation where it is "necessary to give life, meaning and vitality" to the claim. *Kropa v. Robie*, 88 U.S.P.Q. 478, 480 (C.C.P.A. 1951). As stated in the Manual of Patent Examining Procedure, at §2111.02 (II),

"During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference . . . between the claimed invention and the prior art. If so, the recitation serves to limit the claim."

Pertinently, in *Poly-America LP v. GSE Lining Technology Inc.*, 72 U.S.P.Q.2d 1685, 1688 (Fed. Cir. 2004), the Court held that in claims to a three-layered textured landfill liner having a preamble reciting "A blown-film textured liner," the preamble term "blown-film" provided a substantive limitation distinguishing over prior art that showed "a similar liner . . . that was manufactured via a cast process."

Here, the preamble recital "a masking member" gives life, meaning and vitality to the claimed subject matter, defining a product different from the large blow moldings to which Yamazaki et al. is directed, especially in conjunction with the "use" recital ("to protect from coating a specific part of an article that is being coated") that further defines "masking." Such masking members are generally manufactured by vacuum and/or pressure forming a sheet (Pub. No. 2006/0057411, paragraph [0004]); it is believed to be well understood by persons skilled in the art that a large blow molding could not be such a masking member. Thus, the preamble recital of "A masking member" with the specific structural definition supplied by the "use" recital negates anticipation of claim 1 by Yamazaki et al.

The Office Action also asserts that "the limitation that the sheet is vacuum or pressure formed" in claim 1 is a "method of making a product" and as such "does not patentably distinguish a claimed product from a product taught in the prior art" because it has not been "shown that the method of making the product inherently results in a materially different product." To the contrary, applicants submit that a product manufactured by vacuum or pressure-

forming a sheet would indeed be recognized by persons skilled in the art as a product materially different from a blow molding as contemplated by Yamazaki et al. In particular, blow moldings are limited to hollow parts generally unsuitable for masking use, whereas the products made by vacuum-forming or pressure-forming sheets are open rather than hollow and, within the scope of claim 1, configured by the molding operation for the defined masking function.

Consequently, the recital "vacuum and/or pressure formed from said modified polypropylene sheet into said prescribed, non-planar, deep drawing or complex shape" is a proper product-by-process recital in claim 1, defining important product attributes different from a blow molding, and as such is entitled to weight in determining the patentability of the claimed subject matter. From this consideration as well, it follows that Yamazaki et al. does not anticipate the product of claim 1.

It should be noted that the masking member should have a precise shape corresponding to the section of the article which is to be protected by the masking member to protect the section completely from the surface treatment such as the coating. Accordingly, the green thermoplastic sheet should have a good moldability for vacuum and/or pressure forming. To form a non-planar, deep drawing shape or complex shape, vacuum and/or pressure forming is the most suitable forming method. It is very difficult -- rather impossible -- to form non-planar, deep drawing shapes or complex shapes by blow molding.

Further, it should be noted that the masking member should have good heat resistance and also good dimensional stability. During the coating process, a high temperature (higher than 150° C) may be effected on the masking member. If the masking member has poor heat resistance, the masking member may deform so the section of the article to be protected from the coating cannot be protected enough by the deformed masking member, and further, the deformed masking member cannot be re-used any more.

From the above-described two standpoints, the modified polypropylene defined in claim 1 provides important beneficial results in the present invention. Applicants therefore further submit that it would not have been obvious from Yamazaki et al. to provide a masking member having the composition and other product features recited in claim 1, and that the recital of those features, in the defined combination, presents a patentable distinction over Yamazaki et al.

*Claims 2, 4 and 5*

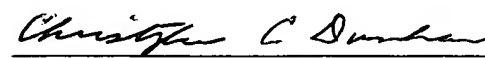
Claims 2, 4 and 5 are believed allowable by virtue of their dependence on claim 1; in addition, claims 2 and 5 present a further patentably distinguishing feature in being limited to the defined presence and range of amount of inorganic filler, which is not seen to be taught or suggested by Yamazaki et al.

*Additional Reference*

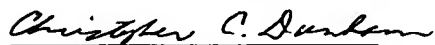
Takeda (JP2001-011259), also newly cited but not applied in the rejection of claim 1, discloses a polypropylene composition consisting of polypropylene component and propylene-ethylene copolymer component. It is described that such component has a good flexibility, transparency, and heat resistance, and further a good moldability. It is described in Takeda that the composition is molded by the injection molding or extrusion molding ([0051]) and it is not described that said composition sheet is vacuum and /or pressure forming.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

  
Christopher C. Dunham  
Reg. No. 22,031  
Attorney for Applicants  
Cooper & Dunham LLP  
Tel.: (212) 278-0400

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Christopher C. Dunham  
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